

3673/18w

Patent

Attorney's Docket No. 003301-162



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of

MEHDI ARAM

Application No.: 10/501,267

Filed: July 9, 2004

For: THERMAL SPRAYING OF A
PISTON RING

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) Group Art Unit: 3673
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) Examiner: Vishal A. Patel
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) Confirmation No.: 7478
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RESPONSE TO RESTRICTION REQUIREMENT

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This Response to Restriction Requirement is in complete response to the Official Action (Restriction Requirement) mailed on October 18, 2005. Applicant respectfully points out that 29 claims are pending in this Application and not 26 as indicated in the Official Action. See the Preliminary Amendment filed on July 9, 2004. Claims 6 and 19 are cancelled and claims 26 to 29 are newly added.

The Examiner has required that the present application be restricted, under 35 U.S.C. §§ 121 and 372, to one of the following two groups of claims:

- **Group I:** claims 1-13 and 26, drawn to a method of applying a wear resistant coating material to a surface of a piston ring.
- **Group II:** claims 14-18 and 20-25, drawn to a piston ring.

Applicant hereby elects, with traverse, the invention defined by the Examiner as Group I which includes method claims 1 to 5, 7 to 13, and 26 to 28. For the reasons set forth below, Applicant requests that the restriction requirement be

modified so that the invention of Group II (*i.e.*, Claims 14 to 18, 20 to 25, and 29) will also be examined.

The restriction is traversed. Application respectfully notes that during review by the International Searching Authority (ISA), the claims of PCT application did not receive a lack of unity rejection. Because unity of invention was found for the PCT application under PCT Rule 13, Applicant submits that the current restriction requirement is improper.

In Caterpillar Tractor Co. v. Commissioner of Patents and Trademarks, 231 U.S.P.Q. 590, 590-1 (E.D. Va 1986), the Court held that a restriction requirement of claims found to have unity runs afoul of Article 27. Article 27 provides in part:

(1) No national law shall require compliance with requirements relating to the form or contents of the international application different from or additional to those which are provided for in this Treaty and the Regulations.

Thus, analogous to the facts of Caterpillar, as this application was filed under 35 U.S.C. § 371 and the claims were found to have unity by the International Searching Authority, the U.S. Patent and Trademark Office cannot now require a restriction. Requiring a restriction would run afoul of Article 27. Accordingly, Applicant requests that the claims of Group II be rejoined with the claims of Group I.

Further, Applicant asserts that the subject matter of the two groups is closely related, and thus it would not be a serious burden on the Examiner to examine the complete subject matter of the claims together. In light of the close relationship between the subject matter of the two sets of claims (Groups I and II), it is believed that a complete search for the subject matter disclosed in all the claims would

overlap. Note that independent Claim 14 explicitly states that a thermal spray process is used. Thus, it would not be a serious burden on the Examiner to examine all the matter disclosed in the claims at this time. Therefore, withdrawal of the restriction requirement and rejoinder of the claims of Groups I-II, and further favorable consideration of all the claims of record on the merits is respectfully requested.

CONCLUSION

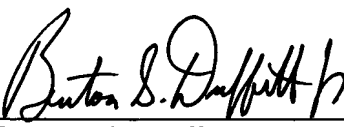
Applicant submits that the present application is fully in condition for examination. An early examination on the merits is earnestly solicited.

In the event that there are any questions relating to this application, it would be appreciated if the Examiner would telephone the undersigned concerning such questions so that prosecution of this application may be expedited.

Respectfully submitted,

BUCHANAN INGERSOLL PC (INCLUDING ATTORNEYS
FROM BURNS DOANE SWECKER & MATHIS)

Date: November 16, 2005

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